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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,698	06/30/2003	Hemingway Huynh	111255-135502	4440

25943 7590 03/14/2006		EXAMINER
SCHWABE, WILLIAMSON & WYATT, P.C.		WON, MICHAEL YOUNG

PACWEST CENTER, SUITE 1900	

ART UNIT	PAPER NUMBER
2155	

1211 SW FIFTH AVENUE
PORTLAND, OR 97204

DATE MAILED: 03/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	10/611,698	HUYNH ET AL.
	Examiner	Art Unit	
	Michael Y. Won	2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>27 December 2005</u>.
2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-10, 23 and 34</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) <u>1-10, 23 and 34</u> is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
    1.☐ Certified copies of the priority documents have been received.
    2.☐ Certified copies of the priority documents have been received in Application No. _____.
    3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date <u>6/30/03</u>.
4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____ .

DETAILED ACTION

1.   This action is in response to the Response to Election/Restriction filed December

27, 2005.

2.   Applicant's election without traverse of Group I (claims 1-10, 23, and 34) in the

reply filed on December 27, 2005 is acknowledged. Claims 11-22, 24-33, and 35-39

have been withdrawn.

3.   Claims 1-10, 23, and 43 have been examined and are pending with this action.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly
claiming the subject matter, which the applicant regards as his invention.

4.   Claims 6 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

Claim 6 recites the limitation "selected rich media element" in page 3 of the

response. There is insufficient antecedent basis for this limitation in the claim.

Claim 10 recites the limitation "earlier IP messages" in page 3 of the response.

There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5.   Claims 1-10, 23, and 34 are rejected under 35 U.S.C. 102(b) as being anticipated

by Tso et al. (US 6,247,050 B1).

INDEPENDENT:

As per *claim 1*, Tso teaches an article comprising:

a storage medium (see Fig.3, #30); and

instructions stored in the storage medium, which, when executed by a processor,

cause the processor to generate one or more messages (see col.6, lines 15-17)

including

logic for testing digital content capabilities of a receiving computer system (see

col.4, lines 22-29 and col.5, lines 46-50); and

logic for displaying one of a plurality of versions of a digital content message

selected based on the results of testing digital content capabilities of the receiving

computer system, such that a receiving computer system may use the contents of the

one or more messages to display the selected version of the digital content message

(see Fig.2, #62; col.4, lines 36-38; and col.7, line 67-col.8, line 3).

As per *claim 6*, Tso teaches a method in a computing system for presenting an

adaptive message, comprising:

receiving a message in the computer system (see col.5, lines 12-15); and

based on the contents of the received message (see col.5, lines 41):

testing two or more digital content capabilities of the computer system

(see col.4, lines 22-29 and col.5, lines 46-50);

selecting one of a plurality of different digital content elements based upon

the results of the testing (see col.6, lines 15-17); and

presenting the selected rich media element (see Fig.2, #62; col.4, lines

36-38; and col.7, line 67-col.8, line 3).

As per *claim 23*, Tso teaches a method in a computing system for serving digital

content elements, comprising:

receiving a digital content element request requesting an identified digital content

element (see col.5, lines 12-15);

extracting from the received request an identifier for a user on whose behalf the

request was issued (see col.5, lines 41-46);

retrieving behavioral information for the identified user (see col.5, lines 44-46);

based on the retrieved behavioral information, selecting a version of the identified

digital content element that best suits the identified user (see col.5, lines 46-50); and

returning the selected version of the identified digital content element (see col.6,

lines 7-17).

As per *claim 34*, Tso teaches an article comprising:

a storage medium (see Fig.3, #30); and

instructions stored in the storage medium, which, when executed by a processor,

cause the processor to generate one or more messages (see col.6, lines 15-17)

including

logic for testing capabilities of a receiving computer system (see col.4, lines 22-

29 and col.5, lines 46-50); and

logic for displaying one of a plurality of versions of a message selected based on

the results of testing capabilities of the receiving computer system, such that a receiving

computer system may use the contents of the one or more messages to display a

version of the message based upon capabilities of the receiving computer system (see

Fig.2, #62; col.4, lines 36-38; and col.7, line 67-col.8, line 3).

DEPENDENT:

As per *claim 2*, which depends on claim 1, Tso further teaches wherein the

instructions, when executed by the processor, generate the one or more messages

such that the *logic* is directly contained in the one or more messages (see col.6, lines

18-25 & 40-42).

As per *claim 3*, which depends on claim 1, Tso further teaches wherein the

instructions, when executed by the processor, generate the one or more messages

such that the *logic* is included in the message by reference (see col.6, lines 18-25 & 40-

62).

As per *claim 4*, which depends on claim 1, Tso further teaches wherein the

instructions, when executed by the processor, generate the one or more messages

such that the *displayed version of the digital content message* is not directly included in the one or more messages, but is separately transferred under the control of the logic for displaying (see col.6, lines 18-25 & 40-42).

As per *claim 5*, which depends on claim 1, Tso further teaches wherein the instructions, when executed by the processor, generate the one or more messages such that the *displayed version of the digital content message* is downloaded by the logic for displaying, and is downloaded in a form customized for an addressee of the message (see col.6, lines 18-25 & 40-42).

As per *claim 7*, which depends on claim 6, Tso further teaches wherein the plurality of digital content elements includes a high-quality video sequence and a low-quality video sequence (see col.4, lines 19-29).

As per *claim 8*, which depends on claim 6, Tso further teaches wherein the plurality of digital content elements includes a video sequence and an animation sequence (see col.4, lines 19-29).

As per *claim 9*, which depends on claim 6, Tso further teaches wherein the plurality of digital content elements includes a first digital content element constructed for playing on a first player and a second digital content element constructed for playing on a second player different from the first player (see col.4, lines 22-29).

As per *claim 10*, which depends on claim 6, Tso further teaches wherein the selected digital content elements is selected based upon actions of a user of the computer system in connection with one or more earlier IP messages for presenting a digital content message (see col.7, lines 16-27).
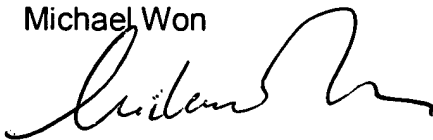
Conclusion

6.   Claims 1-10, 23, and 34 have been rejected and remain pending.

7.   Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Michael Y. Won whose telephone number is 571-272-
3993. The examiner can normally be reached on M-Th: 7AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Saleh Najjar can be reached on 571-272-4006. The fax phone number for
the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the
Patent Application Information Retrieval (PAIR) system. Status information for
published applications may be obtained from either Private PAIR or Public PAIR.
Status information for unpublished applications is available through Private PAIR only.
For more information about the PAIR system, see http://pair-direct.uspto.gov. Should
you have questions on access to the Private PAIR system, contact the Electronic
Business Center (EBC) at 866-217-9197 (toll-free).

Michael Won

March 9, 2006

SALEH NAJJAR
SUPERVISORY PATENT EXAMINER